

## **REMARKS**

Applicants have carefully considered the positions of the Examiner, and respectfully request reconsideration based upon the manifest differences between the present invention and the cited references.

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### **I. THE INVENTION**

The present invention is a system for enabling bi-directional remote operation and control of a plurality of remote devices from a plurality of user workstations.

Specifically, the present invention utilizes a switch for making and breaking connections  
10 between remote devices and input/output devices at user workstations such as display screens, keyboards, and cursor control devices.

Further, the system includes a control circuit coupled to the switch. The control circuit connects to one or more helper circuits, which run programs to aid users in selecting and switching connections with the remote devices. The switch is arranged to  
15 capture pre-selected input sequences designating commands, such as a command to connect the helper circuit, and forward these commands to the control circuit. In response to the input sequences, the control circuit actuates the switch to establish communication between the user workstation and the helper circuit. Importantly, the use of helper commands enables connection to the helper circuit to be initiated at any time,  
20 whether or not the user is currently connected through the switch or to another remote device.

## **II. THE EXAMINER'S REJECTIONS**

### **A. 35 U.S.C. § 102(b)**

The Examiner rejected Claims 30-49 under 35 U.S.C. § 102(b) as unpatentable based upon an alleged offer for sale as evidenced by communications between C-C-C

5 Group and Customer Corporation. Specifically, the Examiner argued that the declaration of Phillip Bates, along with various pieces of correspondence, created an “on sale” bar pursuant to § 102(b).

### **B. 35 U.S.C. § 103**

The Examiner also rejected Claims 30-49 under 35 U.S.C. § 103(a) as being  
10 unpatentable over a facsimile letter from Phillip Bates dated September 29, 1996 to John McDermott (“Bates fax”). The Examiner opined that the letter “taught the claimed invention substantially as claimed including a system for interfacing a plurality of server computers with output and input devices at a plurality of user locations.” However, the Examiner admitted that the claimed invention differs from the disclosure in the letter by  
15 the recitation of helper codes in the input signals.

Furthermore, the Examiner stated that the “[n]ew set of claims 30-49 are no more than rearranging and renaming some of the claim language of old claims 1-29.” In the opinion of the Examiner, pending Claim 30 is canceled Claim 8, pending Claim 37 is canceled Claim 21, and pending Claim 43 is canceled Claim 28, with some of the  
20 terminology renamed and reordered.

**III. THE EXAMINER'S REJECTIONS SHOULD  
BE RECONSIDERED AND WITHDRAWN**

5           **A. 35 U.S.C. § 102(b)**

The Examiner rejected Claims 30-49 under 35 U.S.C. § 102(b) as unpatentable based upon an alleged offer for sale as evidenced by communications between C-C-C Group and Customer Corporation. Specifically, the Examiner argued that the declaration of Phillip Bates, along with various pieces of correspondence, including the Bates fax,  
10   created an “on sale” bar pursuant to § 102(b).

According to the *Pfaff* doctrine, an invention is subject to an offer for sale when an offer is made of an invention that is ready for patenting. *Pfaff v. Wells Elecs., Inc.*, 525 U.S.P.Q.2d 1601, 1607. The “ready for patenting” standard under *Pfaff* has been refined when the invention is a computer system. That is, when a computer system  
15   requires necessary software in order to operate, the software must, at a minimum, be completed at the time of the offer for sale. *Robotic Vision Systems, Inc. v. View Engineering, Inc.*, 112 F.3d 1163, 1997 U.S. App. LEXIS 9605, 42 U.S.P.Q.2d (BNA) 1619 (C.A.F.C. 1997).

In *Robotic Vision*, the plaintiff successfully argued that the invention was not  
20   sufficiently completed because custom software was incomplete. The court found that “the software program, even though not recited in the claims, was necessary for the operation of the invention. Without workable software, there was no device that could have been on sale, and a method of using such a device therefore could not have been on

sale.” *Id.* at 1167. This is directly on point with the subject application -- i.e., the cited reference does not provide a sufficiently complete disclosure.

Here, the claimed invention relates to a multi-user computer system. The system utilizes software to connect a user with a helper circuit through a matrix switch.

5 According to the Bates fax cited by the Examiner “[t]he next free helper pc is connected by the server, through the matrix switch and the user sees and interacts with the application [(i.e., software)] that is running on the helper pc.” Bates fax, p. 1, § 1, ¶ v. Clearly, this application is essential to operation of the invention. In addition, the Bates fax indicates other necessary software applications. For instance, the Bates fax reads  
10 “[w]hen the user is logging in, he is running a custom C-C-C application which will instruct the matrix switch.... The helper pc only needs to run the custom C-C-C login application.” Bates fax, p. 2, § 5, ¶ 1.3.1 and p. 2, § 7. According to the Bates fax, the system, as designed, required custom designed software for operability.

Further evidence of this necessary software is found in a document from C-C-C to  
15 Customer Corp. regarding additional information and clarification for a proposal for a video delivery system (“Additional Proposal Information”). According to the Declaration of Mr. Bates, the Additional Proposal Information was sent in late September or early October 1996. In the section entitled “2.3 System Operation,” paragraph IV essentially recites the need for a custom written program to operate the matrix switch.  
20 Also, a Declaration of Mr. Morisson, including an Exhibit entitled “Video Delivery Project Plan Presented by C-C-C” (“Project Plan”), indicates that this Plan merely provides descriptions of software *necessary* for the operation of the proposed system. See Project Plan, pp. 26-31. In particular, the Project Plan states that “[t]here are

basically three applications which *need to be written* and these will be broken down into their various components at the end of the document.” Project Plan, p. 26 (emphasis added). It is apparent that the required software did not yet exist. As such, it was not available at the time of the alleged “offer for sale” and thus without workable software,  
5 the device could not have been “on-sale”.

In addition, it is black letter law that to be anticipatory a reference must disclose each and every claim limitation. Applicants direct the Examiner’s attention to the Office Action dated September 9, 2004 where the Examiner indicated that, while the claimed invention recites “helper codes,” see e.g. Claim 30, the Bates fax has no such mention of  
10 helper codes. In fact, the Examiner concedes that “at the time of the invention the claimed invention **differed** from the disclosed fax.” Office Action, page 4. (Emphasis added). Since the fax does not disclose each and every claim limitation, even if it is found to represent an “offer for sale”, it does not anticipate the claimed invention.

Accordingly, applicants respectfully request that this rejection be reconsidered  
15 and withdrawn.

**B. 35 U.S.C. § 103**

Next, the Examiner applied his previous rejection of Claims 1-29 to Claims 30-49 under 35 U.S.C. § 103(a) as obvious in light of the Bates fax. The Examiner opined that new Claims 30-49 are no more than rearranging and renaming the claim language of  
20 canceled Claims 1-29. Therefore, according to the Examiner, the previous rejection still applies.

As discussed above, applicants respectfully submit that the 35 U.S.C. § 102(b) rejection has been traversed. Accordingly, the Examiner’s rejection under 35 U.S.C. §

103(a) is also respectfully traversed. Indeed, applicants respectfully direct the Examiner to MPEP § 2141.01, which states that “[a] 35 U.S.C. 103 rejection is based on 35 U.S.C. 102(a), 102(b), 102(e), etc. depending on the type of prior art referenced and its publication or issue date. For instance, an obviousness rejection over a U.S. patent which  
5 was issued more than a year before the filing date of the application is said to be a statutory bar just as if it anticipated the claims under 35 U.S.C. 102(b).” Therefore, because the Bates fax is not a valid 102(b) on sale bar reference as discussed above, it is follows that it is also not a valid reference under 35 U.S.C. § 103(a).

However, even if the Bates fax was available as prior art, applicants respectfully  
10 submit that the Examiners rejection under 35 U.S.C. § 103(a) is still traversed as discussed below.

First, the Examiner stated that canceled independent Claim 8 is essentially the same as independent Claim 30, canceled independent Claim 21 is now Claim 37, and canceled independent Claim 28 is reintroduced as Claim 43. In the opinion of the  
15 Examiner, the only difference between the canceled claims and the new claims is the “renaming and rearranging some of the claim language.”

The Examiner stated that “old claim 8 is now introduced as claim 30 with modification that server computer now becomes ‘remote devices’, supervisory computer now becomes ‘control circuit’ and helper computer now becomes helper circuit and the  
20 helper circuit is brought into the switch paragraph from the supervisory computer paragraph.” Even if them claim terms are just renamed and rearranged, canceled Claim 8 is still not the same as Claim 30. For example, old Claim 8 claims a helper computer to perform the function of being operative to run an interactive program for selecting one or

more remote devices. Claim 30 does not require the helper computer (or even helper circuit) to perform such a function. Rather, it is the control circuit in Claim 30 that is operative to run an interactive program for selecting one or more remote devices. Other differences are also present between Claims 8 and 30.

5           The Examiner then equated canceled Claim 21 with currently pending Claim 37 by stating that “old claim 21 recites ‘ports’ and the new claim 37 changes ports to ‘interface circuits.’” However, even if user interface circuits are the same as the user ports, Claim 37 is still not the same as Claim 21. For example, Claim 37 does not require the user interface circuit to be located at a central location, as Claim 21 requires. Of  
10       course, there are other differences present between Claims 21 and 37, which are not highlighted here for the sake of brevity.

          Applicants submit that the Examiner is also misguided in equating canceled Claim 28 with Claim 43. Canceled Claim 28 claims a method for remotely operating a plurality of servers comprising three (3) steps, including 1) sending input data in a data  
15       stream along with command codes from a user location to a central location, 2) detecting the command codes at a central location and forwarding the command codes and input data, and 3) actuating a switch in response to a command code. Claim 43 is not the same. As opposed to Claim 28, Claim 43 requires a control circuit, a remote device helper circuit, and an interactive program. Clearly, canceled Claim 28 is not the same as  
20       currently pending Claim 43.

          According to the Bates fax, the user “interacts with the application that is running on the helper PC.” Bates fax, p. 1, § 1, ¶ v. It is this application that provides video output to the user and enables the user to connect to the desired remote server.

Conversely, as claimed in Claim 30, the control circuit runs an interactive program (i.e., an application) in order to enable the user to selectively interact with a plurality of remote devices.

Also, significantly absent from the Bates fax is the concept of helper codes as  
5 claimed in Claims 30 and 43. These helper codes are certain keystroke sequences that may be detected, separated from other keystrokes, and sent to the switch, which then operates to connect the user to the helper circuit. Similarly, the concept of detecting and forwarding the detected helper codes to the switch, as in the invention of Claims 30 and 43, is entirely absent from the Bates fax. Thus, the Bates fax would not suggest the  
10 invention of Claim 30 even if it was 1) the same as canceled Claim 8 and 2) appropriate prior art under 35 U.S.C. § 103(a).

Finally, applicants respectfully point out that by merely repeating the rejections previously presented from the Office Action dated January 4, 2002, the Examiner fails to point out anything in the Bates fax that meets or suggests the features of independent  
15 Claims 37 and 43. Applicants therefore request the Examiner, if he maintains his rejection, set forth in the detail for any such rejection of independent Claims 37 and 43 as well as the associated dependent claims.



### CONCLUSION

Applicants respectfully submit that the present application as claimed represents a patentable contribution to the art and the application is in condition for allowance. Early and favorable action is accordingly solicited.

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Date: March 24, 2005

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "D. Hill", written over a horizontal line.

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